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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/799,603

03/15/2004

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1614.1395

8257

21171 7590 09/27/2007
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EXAMINER

HOAR, COLLEEN A

ART UNIT

PAPER NUMBER

3609

MAIL DATE

DELIVERY MODE

09/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/799,603

Applicant(s)

ISOBE ET AL.

Examiner

Colleen Hoar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 8/22/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/15/2004; 8/22/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-17 are examined.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-17 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-17 of copending Application No. 10340642. Although the conflicting claims are not identical, they are not patentably

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distinct from each other because application '603 claims 1-17 include all of the method steps defined in claims 1-17 of the present application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 10, 12-13, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oku (2002/0010756) in view of Guyot et al. (6119098).

As per Claim 1,7

Oku ('756) discloses:

An information distribution method for distributing contents and advertisements from a provider to a user apparatus via a network, comprising: distributing an advertisement with a format requested from the user apparatus. (Page 1, Para 13: ... a system for receiving contents from a web server and providing the contents to a portable terminal connected via a network, a contents-providing system comprises: ... using the user information database when the user ID information and a uniform resource locator (URL) of a web server are input by the portable terminal, and outputting the URL ...; and a data server for requesting that the web server corresponding to the URL ...;provides the contents, processing the contents provided

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by the web server into a predetermined format, and transmitting the processed contents to the portable terminal.; Para 16: ...determining whether the URL is a channel URL that is of a set of URLs of a plurality of web servers that provide contents of a predetermined field; (c) requesting that the respective web servers corresponding to the respective channel URLs provide the contents; (d) reducing image sizes of the contents or reducing a number of colors so as to convert them according to a specification of the portable terminal when the contents are provided by the respective web servers according to the request; and (e) transmitting the converted contents to the portable terminal via the network.)

Oku ('756) does not specifically teach subscriber preferences in terms of content.

Guyot et al. ('098) teaches:

(Col 1, lines 55-67: This invention provides a system and a method for targeting and distributing advertisements over a distributed information network, such as the Internet. The system and method of this invention provide a "client" application that runs on a subscriber's computer. The system and method of this invention also provide a server that manages an advertisement database and that provides advertisements to the "client" application that are targeted to each individual subscriber, based on a personal profile provided by that subscriber; Col 2, lines 55-67: The client application periodically accesses the server over a distributed information network, e.g., the Internet, to download the specifically targeted advertisements. The client application displays the downloaded advertisements on the subscriber's computer, preferably in an

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advertising "window" that is continuously displayed on the subscriber's computer, even if other applications are running concurrently on the subscriber's computer.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Oku ('756) to provide a means to target content matter of the advertisements to the subscriber based on subscriber profile as evidenced by the earlier filing date and patent of Guyot et al.

As per Claim 2, 8, 12, 15

Oku ('756) discloses:

The information distribution method as claimed in claim 1, wherein the format is determined depending on at least one parameter selected from a group of parameters consisting of parameters related to time restrictions, parameters related to image restrictions, parameters related to attribute restrictions, and parameters related to audio restrictions. (Page 3, Para 41: ...receives image information of the contents provided by the web server, reduces image sizes and number of colors and compresses the images so as to fit the image information to ... terminals; Page 4, Para 66: When the converted contents include a plurality of streams, the proxy unit 151 controls the transmission timing of the respective streams and transmits the converted contents.)

Oku ('756) does not specifically teach managing the content preferences of the subscriber.

Guyot et al. ('098) teaches:

(Col 3, lines 23-29: The server 200 stores and manages an advertisement database that includes a personal profile for each subscriber. The subscriber system

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300 periodically access the server 200 to download advertisements that are specifically targeted to the subscriber based on the subscriber's personal profile stored on the server 200. The subscriber system 300 then displays the targeted advertisements.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Oku ('756) to provide a means to manage the format preferences of the subscriber and store and access profiles on a server as evidenced by the earlier filing date and patent of Guyot et al.

As per Claim 3, 5, 13

Oku ('756) discloses:

The information distribution method as claimed in claim 1, further comprising: managing points depending on the advertisement and the format; and controlling distribution of the contents depending on the points. (Page 4, Para 68: Also, since the advertisement contents based on the user information provided by the advertisement server are inserted into the contents provided by the respective web servers to be bound to a channel, and the bound information is transmitted to the portable terminal at one time, advertisement impacts are maximized.)

Oku ('756) does not teach distributing ads to the channel based on subscriber preferences.

Guyot et al. ('098) teaches:

(Col 3, lines 55-65: The database 220 preferably includes Subscriber Data, Advertiser Data, Advertisement Data, Subscriber Statistics, and Client Application Software Data. The Subscriber Data preferably includes, for each subscriber, the

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subscriber's identification information, a password assigned to the subscriber, and a personal profile of the subscriber that is used to target specific advertisements to the subscriber. The subscriber's personal profile is preferably obtained by having the subscriber provide answers to a questionnaire. The answers to the questionnaire are used to build the subscriber's personal profile which is then stored in the database 220.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Oku ('756) to provide a means determined which ads are bounded to the channels based on subscriber preferences as evidenced by the earlier filing date and patent of Guyot et al.

As per Claim 4

Oku ('756) discloses:

The information distribution method as claimed in claim 3, wherein said managing points independently manages the points with respect to each of the contents or, manages the points in common with respect to a plurality of contents. (Page 1, Para 16: ... In another aspect of the present invention, in a contents-providing method of a system for receiving contents from a plurality of web servers and providing the contents to a portable terminal connected via a network, a contents-providing method comprises: ... determining whether the URL is a channel URL that is of a set of URLs of a plurality of web servers that provide contents of a predetermined field; (c) requesting that the respective web servers corresponding to the respective channel URLs provide the contents; ...transmitting the converted contents to the portable terminal via the network.

As per Claim 6, 10, 16

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Oku ('756) does not teach ranking ads based on customer viewing practice.

Guyot et al. ('098) teaches:

The information distribution method as claimed in claim 3, further comprising: allocating surplus points' to other contents if a number of points required to receive one content by the user apparatus is exceeded. (Col 5, lines 12-27: The processor 310 preferably switches to a screen saver mode when the subscriber system 300 has been idle for a predetermined length of time, e.g., when no input activity has been detected over a predetermined length of time. While in the screen saver mode, the processor 310 preferably displays advertisements that have been specifically registered for display during the screen saver mode. (33) When the processor 310 establishes a connection with the server 200, the processor 310 refreshes the queue of the advertisements to be displayed, uploads the Subscriber Statistics to the server 200, and downloads, if necessary, the latest version of the client application software from the server 200. The processor 310 displays the advertisements on a display 330, preferably in a window that is continuously displayed, even if other applications are concurrently running on the processor 310.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Oku ('756) to monitor time, idleness, and screensaver user to display advertisements on client terminal as evidenced by the earlier filing date and patent of Guyot et al.

As per Claim 9

Oku ('756) discloses:

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The computer-readable storage medium as claimed in claim 7, wherein said program further comprises: a procedure causing the computer to manage points depending on the advertisement and the format; and a procedure causing the computer to control distribution of the contents depending on the points. (Para 64-66: The proxy unit 151 of the data server 15 transmits the contents provided by the web servers 40 and the advertisement server 14 to the filter 153 so as to filter information that is not appropriate or needed to be provided to the portable terminal. After the filtering process by the filter 153, the proxy unit 151 calls the image compressor 152, and then reduces the image sizes and the number of colors, or compresses the images to convert the contents in step S220. After this, the proxy unit 151 calls the channel generator 154 and binds the converted respective contents into a channel. In this instance, the channel generator 154 inserts the advertisement contents provided by the advertisement server 14 into the contents processed in the previous step S220 or makes them into an additional page to bind them into the channel. After this, the proxy unit 151 transmits the bound contents to the portable terminal 30 via the Internet 20 in steps S230 and S240. When the converted contents include a plurality of streams, the proxy unit 151 controls the transmission timing of the respective streams and transmits the converted contents.)

Oku ('756) does not specifically teach a number of customer preferences.

Guyot et al. ('098) teaches:

(Col 4, lines 35-67, Col 5, lines 1-5: The Subscriber Context preferably includes the queue of the advertisements to be displayed, and the Subscriber Statistics. The

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Subscriber Context, stored in the memory 320, preferably includes the following data for each advertisement: [a number of points].)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Oku ('756) to queue ranked ads on subscriber terminal for viewing as evidenced by the earlier filing date and patent of Guyot et al.

Claims 11,14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oku (2002/0010756) in view of Guyot et al. (6119098) and in further view of Chatani (7047302).

As per Claim 11

Oku ('756) discloses:

An information distribution apparatus for distributing contents and advertisements from a provider to a user apparatus via a network, comprising: a unit to distribute an advertisement with a format requested from the user apparatus. (Para 68: Also, since the advertisement contents based on the user information provided by the advertisement server are inserted into the contents provided by the respective web servers to be bound to a channel, and the bound information is transmitted to the portable terminal at one time, advertisement impacts are maximized.)

Oku ('756) does not specifically teaches advertisers customizing their ads based on viewer preferences.

Chatani et al. ('302) teaches:

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(Col 3, lines 62-67: That is, merely by contracting with and following a prescribed format determined by the primary media content provider, advertisers are then able to easily manufacture their own advertisement containing CD-ROM or DVD media discs which are easily distributed to customers.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Oku ('756) to provide a means for advertisers to customize ads to meet the preferences of subscribers.

As per Claim 14, 17

Oku ('756) discloses tracking user activity but not a free service business model.

Guyot et al. ('098) teaches:

A business method for providing free contents service to a user by distributing contents and advertisements from a provider computer to a user apparatus via a network, and charging advertising fees for the advertisements to an advertiser, said business method comprising: managing points depending on an advertisement and a format requested from the user apparatus; and distributing the advertisement with the format requested from the user apparatus, and controlling distribution of the contents depending on the points. (Col 6, lines 6-29: In the preferred embodiment, the processor 310 assigns "credits" to the subscriber based on the number of advertisements the subscriber has been exposed to. This information may then be used to provide remuneration to the subscriber based on the number of advertisements displayed on the subscriber system 300. The total credit amount indicator 542 represents the number of credits the subscriber has earned over a predetermined period of time. The processor

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310 preferably sends the total credit amount information to the server 200 when a connection is established with the server 200. The virtual credit amount indicator 544 indicates the number of credits to upload. The processor 310 sends this information to the server 200 when a connection is established. The server 200 preferably utilizes this information to update the subscriber's total credit amount stored on the server data 220, and sends the new total credit amount to the processor 310 for display in the total credit amount indicator 542. The total credit amount is a value that is determined based on the total number of advertisements that have been displayed on the subscriber system 300. As explained above, the total credit amount may be used to provide remuneration to the subscriber based on the number of advertisements that have been displayed on the subscriber system 300.)

Chatani et al. ('302) teaches:

(Col 3, lines 10-17: A further object of the invention is to provide a system and method as described above, wherein a record is maintained of times and durations for which a customer has elected to view auxiliary content along with viewing of valuable media content, wherein an auxiliary content viewing record is subsequently uploaded to the server station maintained by the content provider and can be used as a basis for assessing advertising fees to an advertiser, as well as updating of the customer database; Col 3 lines 41-46: Therefore, advertisers are afforded great flexibility in preparing their own advertising content on relatively low cost packaged media, where at the same time advertisers can associate their auxiliary content with specified valuable media content downloadable from a main content provider)

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Oku ('756) in view of Guyot et al. ('098) to include free content to subscribers and further in view of Chatani et al. ('302) to provide a means to track instances of observations of ads and determine advertising fees from subscriber activity.

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Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Marcus (2002/0092019) reached creation, distribution, assembly, and verification of media.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Colleen Hoar whose telephone number is 571-270-3447. The examiner can normally be reached on Monday- Thursday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Colleen Hoar
Examiner
Art Unit 3609


THOMAS A. DIXON
SUPERVISORY PATENT EXAMINER